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IN THE

Supreme Court of the United States

October Term, 1973

No. 73-670

THE TRIAX COMPANY,
Petitioner,

v.

HARTMAN METAL FABRICATORS, INC.,
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

To The United States Court of Appeals
For the Second Circuit

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Petitioner bases its principal argument for grant of a writ of certiorari on the contentions:

a) that the Court of Appeals erroneously supposed a prior Chasar patent (No. 3,132,753) and a British patent to Stirling (No. 866,107) were not disclosed in the file wrapper of the Chasar dual command patent (No. 3,139,994), and

b) that the Court of Appeals erroneously supposed the earlier Chasar patent (No. 3,132,753) discloses the same storage-retrieval machine as that disclosed in the Chasar patent No. 3,139,994.

Argument

a) The first above-mentioned contention of Petitioner is based upon a narrow and unwarranted interpretation of the language of the Court of Appeals decision. The Court of Appeals in its decision was pointing out that the Patent Office Examiner in his examination of the patent application, which matured into Patent No. 3,139,994, did not *cite* against that application the prior Chasar Patent No. 3,132,753, and that therefore the presumption of validity of Patent No. 3,139,994 is severely undercut. As a matter of fact all that the Examiner did was to admonish Chasar (PX45, p. 212) in the early stages of prosecution of the application that matured into Patent No. 3,139,994, to maintain a proper line of distinction between the claims of that application and those of the copending application that subsequently matured into Chasar Patent No. 3,132,753. After that the Examiner ignored the application which matured into the '753 patent, and the '753 patent itself. Patent No. 3,132,753 is not even included among the 27 references listed at the end of Patent No. 3,139,994 (PX1, R. Vol. II, p. 53) as *cited* in the file of this patent. The contention of Petitioner that the Court of Appeals was in error as regards Chasar Patent No. 3,132,753 therefore is not supported by the file wrapper of the Chasar Patent No. 3,139,994 itself.

It is true that the French Stirling Patent No. 1,227,258 shows the equivalent of the British Patent No. 866,107 and was cited by the Examiner during the pendency of the application which matured into Patent No. 3,139,994; but the French patent was not cited until the final office action in that application, and even then was not used to reject any claims (PX45, p. 235, R. Vol. II, p. 262). It would appear that the Examiner did not fully appreciate the disclosure of that French patent since it was in French, not English.

In any event the Court of Appeals has considered the Chasar dual command Patent No. 3,139,994 *in view of* the Chasar Patent No. 3,132,753 and the Stirling British Patent No. 866,107 *in combination* and has held that in view of these two patents ". . . the conclusion seems inescapable that the dual command means was obvious to anyone with ordinary skill in the art." (A 16, 17).

35 U. S. C. 103, Conditions for Patentability: Non-Obvious Subject Matter

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. * * *" July 19, 1952, c. 950, § 1, 66 Stat. 798.

b) As regards the contention of the Petitioner that the Court of Appeals erroneously supposed the earlier Chasar '753 patent discloses the same storage-retrieval machine as that disclosed in the Chasar '994 patent, all we need do is to point to Chasar's own statement with respect to the relation between the disclosures of these two patents. Chasar says (column 3, lines 24 to 35 of the '994 patent):

> "While the present invention might be adapted to various apparatus or uses, it has been chosen to show the same for mechanical storage equipment taking the form of a load transfer and storage apparatus *substantially the same in structure as* that *disclosed in my copending United States patent application, Serial No. 813,585*, filed May 15, 1959 by Anthony R. Chasar and Walter F. Double . . . to which reference may be had

> for further disclosure, if necessary, to more clearly understand the present invention and to complete the present disclosure" (emphasis added) (PX1, R. Vol. II, p. 22)

Application Serial No. 813,585 matured into the Chasar '753 patent.

Petitioner's own statement made at the time of filing of the application that matured into the Chasar '994 patent, and contained in the '994 patent itself therefore *completely refutes* Petitioner's present contention that the Court of Appeals erroneously supposed the earlier Chasar '753 patent discloses the same storage-retrieval machine as that disclosed in the Chasar '994 patent.

The Presumption of Validity Is Only a Presumption

The presumption of validity of a patent (35 U. S. C. 282) is only a presumption; and the grant of a patent by the Patent Office is no absolute guarantee of its validity.

The Court of Appeals has found the alleged invention of Patent No. 3,139,994 obvious on a ground not considered by the Patent Examiner.

Patent No. 3,139,994 claims a load transfer apparatus in which a load can be taken from a load station by a load carrier and stored in a bin of a storage rack, and thereafter the return trip of the load carrier to the load station is interrupted and the load carrier is sent to another bin of the rack to remove a load from the latter bin and carry that load to the load station. The prior Chasar Patent No. 3,132,753 could be programmed either to carry a load from the load station to store the load in a bin of the storage

rack or to go to a bin of a storage rack, take a load therefrom and bring that load to the load station. We submit that if it was desired to deposit a load in one bin and to take another load from another bin, anyone with horse sense would know enough to interrupt the return of the carrier to the load station after depositing a load and send the carrier on to the other bin to pick up the other load. There was no invention, therefore, in Patent No. 3,139,994 over the disclosure of Patent No. 3,132,753: Patent No. 3,132,753 discloses the basic storage retrieval mechanism claimed in Patent No. 3,139,994. But aside from this, British Patent No. 866,107 discloses dual command apparatus for transferring a load from a load station to a bin and thereafter going to another bin to pick up a load before returning to the load station. The Court of Appeals therefore was right in holding that the dual command means of Patent No. 3,139,994 "was obvious to anyone with ordinary skill in the art".

Patent No. 3,139,994 Was Not a Pioneering Patent

In the first paragraph on Page 4 of Petitioner's Petition, Petitioner seems to imply that the development of equipment to store materials automatically started with it in 1959 and with its Patent No. 3,139,994. The Lemelson Patent No. 3,119,501 (one of three patents involved in this litigation) belies this. It discloses automatically-operating storage equipment; and the application from which it matured was filed July 28, 1954, more than six years before the application that matured into Patent No. 3,139,994 was filed.

There Is No Basis For Issuance of a Writ of Certiorari

The question here involved is a mere matter of patentability. The Court of Appeals decision is not in conflict with the decision of another court of appeals. It has not decided an important question of federal law which had not been, but should be settled by this Court; nor has it decided a federal question in a way in conflict with applicable decisions of this Court; nor has it so far departed from the accepted and usual course of judical decisions as to call for an exercise of this Court's power of supervision (Rule 19 (b), Rules of the Supreme Court of the United States).

Conclusion

For the above reasons it is submitted the Petition should be denied.

Respectfully submitted,

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